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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,746	03/05/2002	Ute Griesbach	CU-2652 RJS	8970

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EXAMINER	
FONDA, KATHLEEN KAHLER	
ART UNIT	PAPER NUMBER
1623	7

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/936,746	GRIESBACH ET AL.	
	Examiner	Art Unit	
	Kathleen Kahler Fonda, Ph.D.	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1-29-03 (IDS)* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

For the purpose of priority under 35 U.S.C. 371, Applicant should amend the specification to make specific reference to the earlier filed application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, "use" is not a statutory class of invention. The claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process. The claim is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The term "loosened" in claim 3, line 3, has no recognized meaning pertaining to bonding in the chemical arts. Thus the scope of the claim cannot be determined.

Claim 10 provides for the use of glucan/chitosan mixtures, but fails to set forth any steps involved in the method or process. Thus, it is unclear what Applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZÜLLI *et al.* (A) in view of WEITKEMPER *et al.* (B).

Applicant claims cosmetic preparations which contain water soluble β-(1,3) glucans and chitosans. Claims 2-4 recite process steps for obtaining the glucan. Claims 5 and 6 require specified molecular weight ranges for the chitosan. Claims 7 and 8 require that the chitosan be carboxylated or succinylated, respectively. Claim 9 recites particular relative amounts of the glucan and the chitosan. Claim 10 is drawn to "use" of

mixtures of glucan and chitosan for preparing cosmetic preparations.

ZÜLLI teaches water soluble β-(1,3) glucans and their use in cosmetic compositions; see, for example, the abstract and claim 5. The Examiner notes that the amount of glucan in claim 5 overlaps that of instant claim 9. The glucans do not have β-(1,6) linkages; see column 1.

ZÜLLI does not specifically disclose inclusion of chitosan in cosmetic compositions.

WEITKEMPER teaches that chitosans of varying molecular weights and amounts within the scope of the claims, including carboxylated and succinylated chitosans, are known to be useful in cosmetic preparations; see column 2, line 43 to column 3, line 29.

It would have been obvious for a person of ordinary skill in the art at the time of the invention to provide a cosmetic preparation containing water soluble β-(1,3) glucans and chitosans. A worker of ordinary skill in the art would have been motivated to do so because both of these substances were known in the art to be useful in cosmetic preparations. It is well established that no patentable invention resides in combining old ingredients of known characteristics where the results obtained thereby are no more than the additive effects

of the ingredients. See *In re Sussman*, 1943 C.D. 518; *In re Huellmantel*, 139 USPQ 496; and *In re Crockett*, 1266 USPQ 186. Also, it is obvious to combine ingredients which have been separately employed for a given purpose in order to obtain the expected combination of benefits. See *In re Greenfield*, 571 F.2d. 1185, 197 USPQ 227 (CCPA 1978). There has been no clear and convincing showing (see *In re Lohr*, 137 USPQ 548), commensurate in scope with the claims (see *In re Lindner*, 173 USPQ 356; *In re Hyson*, 172 USPQ 339, and *In re Boesch*, 205 USPQ 215 (CCPA 1980)), of any unexpected results.

The Examiner notes that Applicant has presented Table 1 concerning skin aging and roughness after administration of compositions containing chitosan and/or β-(1,3) glucan in varying amounts. The data do not provide adequate evidence of synergistic results because according to page 17 of the specification, all measurements are made relative to the skin condition as it existed at the outset of the treatment. There does not appear to have been any objective assessment of skin condition before the treatment was started. For example, there is no indication that the skin condition of the subjects who received chitosan alone was the same at the start of the treatment as that of the subjects who received chitosan and β-(1,3) glucan.

As for claims 2-4, the Examiner notes that the claims are drawn to preparations, and not to processes. Recitation of process steps for obtaining the glucans are not seen to provide a patentable limitation for claims drawn to preparations. A product by process claim is a claim to the product, regardless of how it was made.

Leuba *et al.* (C) and Teslenko *et al.* (D) are cited to indicate the state of the art at the time of the invention more completely. Leuba teaches that chitosan may be added to cosmetic preparations to inhibit the growth of microorganisms; see the abstract. Teslenko teaches preparation of chitosan-glucan complexes from biological sources; see the abstract.

No claim is allowed.

Papers relating to this application may be submitted to Technology Center 1600 by facsimile transmission. The number of the fax machine for official papers in Technology Center 1600 is (703) 308-4556. Any document submitted by facsimile transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

INTERNET INFORMATION: Secure and confidential access to patent application status information is now available; see http://www.uspto.gov/ebc/index.html for more information. Also, http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm may be used to pay patent maintenance fees, pay non-filing application fees, and maintain USPTO deposit accounts.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kathleen Kahler Fonda, at telephone number (703) 308-1620. Examiner Fonda can generally be reached Monday through Friday from 7:30 a.m. until 4:00 p.m. If the Examiner cannot be reached, questions may be addressed to Supervisory Patent Examiner James O. Wilson at (703) 308-4624. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

Kathleen Kahler Fonda, Ph.D., J.D.
Primary Examiner
Art Unit 1623